

REMARKS

[0005] Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. Applicant respectfully requests entry of the amendments herein. The remarks and amendments should be entered under 37 CFR. § 1.116 as they place the application in better form for appeal, or for resolution on the merits.

[0006] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 2, 4-22 and 24-28 are presently pending. Claims 12, 20, 24, and 26 are amended herein. No claims are withdrawn or cancelled herein. No new claims are added herein.

Formal Request for an Interview

[0007] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can discuss this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0008] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Claim Amendments

[0009] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 12, 20, 24, and 26 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and are merely intended to highlight the claimed features. The amendments should not be construed as further limiting the claimed invention in response to the cited references.

Substantive Matters

Claim Rejections under § 103

[0010] Claims 1, 2, 4-22 and 24-28 are rejected under 35 U.S.C. § 103(a). In light of the discussion during the above-discussed Examiner interview, the amendments and discussion presented herein, and the exhibits and declarations submitted herewith, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0011] The Examiner's rejections are based upon the following references in combination:

- **Zigmond:** *Zigmond, et al.*, US Patent No. 6,698,020 (issued February 24, 2004);
- **Eldering 129:** *Eldering*, US Patent No. 6,216,129 (issued April 10, 2001);
- **Eldering:** *Eldering, et al.*, US Patent Application Publication No. 2004/0148625 (published July 29, 2004); and
- **Aras:** *Aras, et al.*, US Patent No. 5,872,588 (issued February 16, 1999).

Declarations and Exhibits

37 C.F.R. 1.132 Declaration regarding ownership – Maples

[0012] Applicant herewith submits a declaration under 37 CFR 1.132 and accompanying exhibits A, B, and C indicating the fact that WebTV Networks, Inc. and all of the assets of WebTV Networks, Inc., including the application which matured to become *Zigmond* were owned by Microsoft Corporation before October 1, 2003, the date that the subject matter of the instant application was conceived by the inventors.

37 C.F.R. 1.131 Declaration regarding Prior Invention – De Heer

[0013] Applicant herewith submits a declaration under 37 CFR 1.131 and accompanying redacted exhibits D, E, F, G, H, I, and J indicating the fact that the inventor conceived of the subject matter of the instant application and exercised due diligence from before February 24, 2004, the effective date of the reference *Zigmond*, until filing of the instant application on March 10, 2004, constituting constructive reduction to practice.

37 C.F.R. 1.132 Declaration regarding diligence – Brant

[0014] Applicant herewith submits a declaration under 37 CFR 1.132 and accompanying redacted exhibits K, L, M, N, O, and P indicating the fact that due diligence was exercised from before February 24, 2004, the effective date of the reference *Zigmond*, until filing of the instant application on March 10, 2004, constituting constructive reduction to practice.

[0015] Applicant's representatives are attempting to locate inventors Ludvig and Sheldon. However, these inventors are not currently employed by the Applicant. Because we have not yet been able to contact them regarding the declaration under 37 CFR 1.131, only the declaration signed by inventor De Heer is submitted herewith.

[0016] Therefore, Applicant respectfully asserts that the evidence, taken as a whole demonstrates that *Zigmond*, published after invention by the Applicant of the subject matter of the instant application, is properly accorded an effective date under 35 U.S.C. § 102(e) with respect to the instant application.

CITED ART SUBJECT TO OBLIGATION OF ASSIGNMENT TO SAME
ASSIGNEE – 35 U.S.C. § 103 (C)

[0017] Applicant respectfully requests that the Examiner remove U.S. Patent No. 6,698,020 to *Zigmond* as a prior art reference in prosecution of the instant application as a result of the following statement as set forth in the Manual of Patent Examining Procedure, 706.02(l)(2) II.

[0018] The instant application and the cited reference, U.S. Patent No. 6,698,020, at the time the invention of the instant application was made, were commonly owned by Microsoft Corporation. Applicant respectfully submits that the cited reference, U.S. Patent No. 6,698,020, only qualifies as prior art under § 102(e), and shared a common owner with the instant application at the time the subject matter of the instant application was conceived. Thus, U.S. Patent No. 6,698,020, cited in combination with *Eldering*, US Patent No. 6,216,129, under § 103(a) should be disqualified under § 103(c).

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0019] The Examiner rejects claims 1, 2 and 4-11 under 35 U.S.C. § 103(a) as being unpatentable over *Zigmond* in view of *Eldering* 129. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. In light of the discussion presented herein and the exhibits and declarations submitted herewith Applicant submits that these rejections are moot.

[0020] The Examiner rejects claims 12-22 and 24-28 under 35 U.S.C. § 103(a) as being unpatentable over *Eldering* in view of *Aras*. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. In light of the amendments and discussion presented herein and the exhibits and declarations submitted herewith Applicant submits that these rejections are moot.

Overview of the Application

[0021] The Application describes a technology for targeting advertisements based on consumer purchasing data. Profiles are generated for broadcast television system subscribers based on consumer purchasing data maintained, for example, by retail and service providers. A particular advertisement is targeted by associating the advertisement with one or more characteristics from a consumer profile which also identifies client devices associated with consumers. A client device is configured to receive a message indicating an upcoming targeted advertisement, compare locally stored subscriber profile data with the profile characteristics associated with the targeted advertisement, and

determine whether to tune to the targeted advertisement or to allow the default advertisement to be rendered.

Cited References

[0022] The Examiner alternately cites *Zigmond* or *Eldering* as the primary reference in the obviousness-based rejections. The Examiner correspondingly alternately cites *Eldering 129* and *Aras* as secondary references in the obviousness-based rejections.

[0023] *Zigmond* describes a technology for selecting and inserting advertisements into a video programming feed at the household level.

[0024] *Eldering 129* describes an advertisement selection system of vectors describing an actual or hypothetical market for a product or desired viewing audience.

[0025] *Eldering* describes an ad management system (AMS) for managing sales and insertion of targeted advertisements into advertising opportunities.

[0026] *Aras* describes content coding of Audio-Visual materials.

Independent Claim 1

[0027] In light of the evidence submitted and requested removal of *Zigmond* as a prior art reference, Applicant asserts that the remaining references do not disclose, teach, or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claims 12, 20, 24, and 26

[0028] Applicant submits that each of these independent claims as amended recites at least one similar element to those recited in claims 1, 2, and 4-11, for which the Office Action relies on *Zigmond* in its rejections. In light of the evidence submitted and removal of *Zigmond* as a prior art reference, Applicant asserts that the remaining references do not disclose, teach, or suggest all of the elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejections of these claims.

Dependent Claims 2, 4-11, 13-19, 21, 22, 25, 27, and 28

[0029] These claims ultimately depend upon one of independent claims 1, 12, 20, 24, and 26. As discussed above, claims 1, 12, 20, 24, and 26 are allowable over the cited references. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable over the cited references. Additionally, some or all of these claims may also be allowable for additional independent reasons. Applicant respectfully requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

[0030] Applicant respectfully asserts that all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC
Representatives for Applicant

/Bea Koempel-Thomas 58213/ Dated: 12/29/2008
Beatrice L. Koempel-Thomas (bea@leehayes.com; 509-944-4759)
Registration No. 58213

Assistant: Cherri Simon (cherri@leehayes.com; 509-944-4776)

Customer No. **22801**

Telephone: (509) 324-9256
Facsimile: (509) 323-8979
www.leehayes.com